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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,760	10/05/2001	Akihiko Toyoshima	50P4257.03	4600

36738 7590 12/12/2006

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SAN DIEGO, CA 92101

EXAMINER

NGUYEN, STEVEN H D

ART UNIT PAPER NUMBER

2616

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/972,760		TOYOSHIMA, AKIHIKO	
	<b>Examiner</b>		<b>Art Unit</b>	
	Steven HD Nguyen		2616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 November 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,10,11,13,15,17-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,10,11,13,15,17-19 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 11 and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hanava (USP 5450471).

Regarding claims 1, 11 and 17, Hanava discloses a method and system for providing a multiple format wireless phone (Figs 6-7, 10, 11 and 15) comprising a wireless phone (Fig 6, Ref 1, Figs 7 and , Ref 11, Fig 11, Ref 730 and Fig 15, Ref 780) having a first wireless communication format (Analog or digital, first or second system, Col. 3, lines 9-13) configured to removably receive at least one wireless module (Fig 7, Ref 13, Fig 10, ref 13A, Fig 11, ref 710 and Fig 15, ref 760) having a second wireless communication format (Analog or digital, first or second system, Col. 3, lines 9-13) and said wireless module in electronic data communication with the wireless phone (Figs 7, 10-11 and 15, the telephones is coupled via electronic data communication), said wireless module configured to provide the second format to the phone (Analog or digital, first or second system, Col. 3, lines 9-13), wherein the module includes a mobile station identification number, said wireless phone configured to receive said mobile station identification number upon verification of proper operation of the module to facilitate use of a single phone number with both formats (Fig 6, Ref 9 and 10 used to verify the conditions of the portable telephone and transferring the conditions information and subscriber's number etc...

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to the wireless phone; Fig 6, Ref 1, Figs 7 and , Ref 11, Fig 11, Ref 730 and Fig 15, Ref 780, so that the telephones can be use with the same telephone number, See col. 9, lines 48-50, col. 11, line 55 to col. 12, line 59).

Regarding claim 18, Hanava discloses operational data comprises at least one wireless format (Analog or digital, first or second system, Col. 3, lines 9-13).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-5, 10, 13, 15, 19 and 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Hanava in view of Metroka (USP 5249302).

Regarding claims 2-3, 13 and 21, Hanava fails to disclose providing at least one wireless module comprises utilizing at least one wireless format selected from the group consisting of CDMA ONE, CDMA 2000 1X, CDMA 2000 3X, CDMA 1X EV, Wideband CDMA, GSM, GPRS and EDGE. In the same field of endeavor, Metroka discloses a multiple mode telephone system herein a wireless module utilizing at least one wireless format selected from the group consisting of CDMA, TDMA "GSM" (Col. 12, lines 19-39).

Since, Hanava discloses a dual mode telephone system containing two formats such analog and digital. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply CDMA and TDMA format as disclosed by Metroka

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into the system and method of Hanava. The motivation would have been to utilize of additional transmission capacity of cellular communication system.

Regarding claims 4-5, 10, 15 and 19, Hanava fails to disclose providing said wireless module with an electronic serial number for storing to wireless phone. In the same field of endeavor, Metroka discloses providing said wireless module with an electronic serial number for storing to wireless phone (Col. 14, line 62 to col. 15, Line 3 and col. 15, lines 32-38 and col. 17, lines 1-28).

Since, Hanava discloses a dual mode telephone system containing two formats such analog and digital wherein a wireless module provides a subscriber's number such as ID information to the wireless phone. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method and system for providing the radiotelephone serial number of the wireless module to the wireless telephone as disclosed by Metroka into the system and method of Hanava. The motivation would have been to utilize of additional transmission capacity of cellular communication system.

### ***Response to Arguments***

5. Applicant's arguments filed 11/14/06 have been fully considered but they are not persuasive.

In response pages 1-3, the applicant states that Hanava does not disclose storing the mobile station identification number to the wireless phone only upon determination that the wireless module provides proper operation in an intended area to facilitate communication using a common phone number with either format. In reply, Hanava clearly discloses storing the

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mobile identification number to the wireless phone upon determination that the wireless module provides proper operation in an intended area to facilitate communication using either format as showed in Fig 6, Ref 9 and 10 used to verifying if the wireless module works with intended area by identifying control channel, radio frequency for connection with the base stations. Then transferring the identifier number to the wireless telephone in order to allow wireless phone to facility a communication with the formats of the first and second system. (Fig 6, Fef 1, Figs 7 and., Ref 11, Fig 11, Ref 730 anà Fig 15, Ref 780 and col. 9, lines 48-50 and col. 11, lines 55 to col. 12, lines 24, the identifying od detecting means used to check “verify” for conditions of the frequency and control channel of the portable phone and its base stations, then forwarding these conditions and mobile ID to the communication unit in order to allow the system use the same phone number in both format when the device roam from a first to second system. If the device can detect or identify communication conditions implying the device verified that it properly working in the area. Because, the device must exchange the information with the base station before determining if the device works in this area or not) as stated in claim 1. Furthermore, the applicant states that “changing formats” is not the same for changing the radio frequenc and control channel between the first company and second company such as analog and digital. In reply, “changing formats” is the same with changing from analog to digital or form first company to second company because it has different format. Therefore, changing format reads on changing from analog to digital or form first company to second company in the broadest term.

In resposne to page 3-4, the applicant states that the examiner inorges the limitation “only” in the claim (1) and using a single telephone number for both format (2). In reply, with

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respect to (1) the examiner does not ignore this limitation. Havana clearly disclose if the communication conditions between the portable and the intended area are not proper. Then, the portable device can not identify or detect the frequency and control channel. So, it is clearly reads on the term only. With respect to (2), Havana clearly shows a single number used for both formats (col. 11, lines 55 to col. 12, lines 59 and col. 13, line 59 to col. 14, line 3, a subscriber's number is used for both portable "first format" and automobile telephone "second format" of communication unit).

### ***Conclusion***

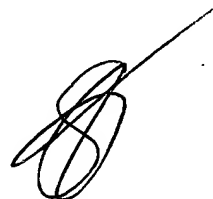
6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (571) 272-3159. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on (571) 272-3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Steven HD Nguyen  
Primary Examiner  
Art Unit 2616